

### **REMARKS/ARGUMENTS**

Claims 1-37 remain in the application. Claims 20-37 have been added. The examiner rejected claims 1-19 in the Office Action mailed February 11, 2004 (hereinafter referred to as "Office Action").

Applicant respectfully requests a three month extension of time to respond to the Office Action until August 11, 2004. The Commissioner is hereby authorized to charge the statutory fee to the undersigned's deposit account no. 50-0653. Applicant hereby claims small entity status. In view of the following remarks and amendments, applicant respectfully request a timely Notice of Allowance be issued in this case.

Support for the amendments and newly added claims can be found throughout the application. Applicants respectfully submit that no new matter is added by the amendments and newly added claims.

#### ***Corrected Drawings***

The examiner required corrected drawings to be submitted. Applicant respectfully submits that five (5) sheets of formal drawings were submitted to the PTO on October 26, 2000. Copies of the previously submitted drawings are attached in compliance with the examiner's requirement.

#### ***Amendment to the Title***

The Title of the application has been amended to more accurately reflect the claimed invention. In particular, watermarking is not required by all claims and has been removed from the title.

#### ***Claim Rejections under 35 U.S.C. § 102***

The examiner rejected claims 1-2 and 9-10 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,793,980 to Glaser. Specifically, the examiner stated that Glaser teaches an audio on demand communication system. For anticipation, a single reference must identically disclose every element of the claimed invention. *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

With respect to claims 1 and 9, as amended, applicant respectfully submits that Glaser does not disclose a method or system that closes the portable file each time a song or act is completed. Instead, Glaser only converts, compresses and stores the received audio data (col. 6, lines 10-22). Moreover, Glaser is directed to providing real-time,

audio-on-demand to a personal computer from a disk storage unit via a primary server (col. 5, line 38-col. 6, line 49; Figure 2A). Glaser does not record a live performance and individually transmit portable files for each song or act. Applicant respectfully submits that claims 1 and 9, as amended, are not anticipated by Glaser and are, therefore, allowable under 35 U.S.C. § 102.

With respect to claims 2 and 10, applicant respectfully submits that claims 2 and 10 depend from claims 1 and 9, respectively, which are allowable for the reasons stated above, and further distinguish over the cited references. Accordingly, applicant respectfully submits that claims 2 and 10 are not anticipated by Glaser and are, therefore, allowable under 35 U.S.C. § 102.

### ***Claim Rejections under 35 U.S.C. § 103(a)***

The examiner rejected claims 3, 5-6, 11 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Glaser in view of U.S. Patent No. 6,442,283 to Tewfik. The examiner also rejected claims 4 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Glaser and Tewfik as applied to claim 3, and further in view of U.S. Patent No. 5,664,018 to Leighton. In addition, the examiner rejected claims 7-8 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Glaser in view of U.S. Patent No. 6,338,044 to Cook. Moreover, the examiner rejected claims 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Glaser in view of U.S. Patent No. 6,052,470 to Mouri.

In order to establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; *In re Vacek*, 947 F.2d 488 (Fed. Cir. 1991). "The prior art must suggest the desirability of the claimed invention." MPEP § 2143.01. **Both the invention and the prior art references must be considered as a whole.** MPEP § 2141.02. Applicant respectfully submits that claims 1-37, as amended, are not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

Unless the reference(s) teach or suggest all the claim limitations, obviousness cannot be found. MPEP § 2143.03. Further, once an independent claim is found to be non-obvious under 35 U.S.C. § 103, then any claim which depends from that independent claim is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). For the reasons stated below, applicant respectfully submits that the cited references do not disclose, teach or suggest all the claim elements of claims 1-37, as amended.

### ***Claims 1 and 9***

With respect to claims 1 and 9, as amended, and as previously discussed, applicant respectfully submits that the cited references do not disclose, teach or suggest

the step of closing said portable file and transporting said portable file over a network each time a song or act is completed. Accordingly, applicant respectfully submit that claims 1 and 9, as amended, is not obvious over the cited references, and are, therefore, allowable under 35 U.S.C. § 103(a). Applicant respectfully request that the rejection of claims 1 and 9, as amended, be withdrawn.

***Claims 2-8 and 10-17***

With respect to claims 2-8 and 10-17, applicant respectfully submits that claims 2-8 and 10-17 depend from claims 1 and 9, respectively and as amended, which are allowable for the reasons stated above, and further distinguishes over the cited references. Claims 2-8 and 10-17 are, therefore, allowable under 35 U.S.C. § 103(a). Accordingly, applicant respectfully request that the rejection of claims 2-8 and 10-17 be withdrawn.

***Claim 18***

With respect to claim 18, applicant respectfully submits that the cited references do not disclose, teach or suggest the a processing unit that converts said combined signals to a plurality of time-synchronized and locked digital signals. Accordingly, applicant respectfully submits that claims 18, as amended, is not obvious over the cited references, and is, therefore, allowable under 35 U.S.C. § 103(a). Applicant respectfully requests that the rejection of claim 18, as amended, be withdrawn.

***Claim 19***

With respect to claim 19, applicants respectfully submit that claim 19 depends from claim 18, as amended, which is allowable for the reasons stated above, and further distinguishes over the cited references. Claim 19 is, therefore, allowable under 35 U.S.C. § 103(a). Accordingly, applicant respectfully requests that the rejection of claim 19 be withdrawn.

***Claim 20-37***

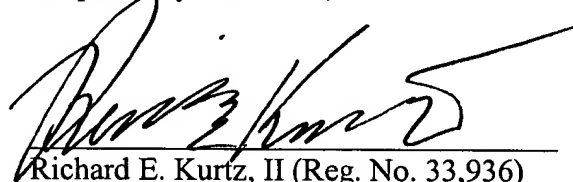
With respect to newly added claims 20-37, applicant respectfully submits that a these claims allowable under 35 U.S.C. § 103(a).

Appl. No. 09/620,572  
Amdt. dated Aug. 11, 2004  
Reply to Office action of Feb. 11, 2004

***Conclusion***

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the rejections. Applicant submits that claims 1-37, as amended, are fully patentable. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick Kurtz", written over a horizontal line.

Richard E. Kurtz, II (Reg. No. 33,936)  
Attorney for Applicants

GREENBERG TRAUIG  
1750 Tysons Boulevard, 12<sup>th</sup> Fl.  
McLean, VA 22102  
(703) 749-1330  
E-mail: kurtzr@gtlaw.com

Filed: 8/11/04